

REMARKS

In response to an Official Action dated February 24, 2006, Applicant respectfully submits the following remarks. This application contains claims 1, 4-19 and 22-37, all of which were rejected in the present Official Action. Reconsideration is respectfully requested in view of the remarks that follow.

Claims 1, 5-11, 19, 23-29, 35 and 36 were rejected under 35 U.S.C. 103(a) over Lorie (U.S. Patent 5,933,531) in view of Jansen et al. (U.S. Patent 6,243,450). Applicant respectfully traverses this rejection.

Claim 1 recites a method for document processing, in which images of document fields are received over a network from a client and are processed to code information contained in the fields. Directory look-up is used to check whether the information is coded correctly. The checked, coded information is returned to the client over the network. Payment is received from the client according to the number of fields that were processed, based upon a price per field processed.

In rejecting claim 1, the Examiner asserted that Lorie discloses the steps of receiving images of fields from a client via a computer network and returning the checked coded information over the network to the client. In response to the previous Official Action in this case, Applicant pointed out that Lorie makes no mention of any sort of client, nor does he mention or even suggest that images might be sent over a computer network and coded information returned over the network. In the Response to Arguments in the present Official Action, the Examiner rejected this argument, on the grounds that that Lorie “discloses executing the method in a network environment, containing clients and servers,” in col. 8, line 50 – col. 9, line 31.

In fact, the passage cited by the Examiner makes no mention at all of clients and refers to servers only in passing, as part of a boilerplate recitation (col. 9, lines 1-9):

“An apparatus for making, using, or selling the invention may be one or more processing systems including, but not limited to, a central processing unit (CPU), memory, storage devices, communication links, communication devices, servers, I/O devices, or any subcomponents or

individual parts of one or more processing systems, including software, firmware, hardware or any combination or sub-combination thereof, which embody the invention as set forth in the claims.” Aside from mentioning “communication devices,” this passage says nothing whatsoever about network communications. It is all but inconceivable that the passing mention of a server in this generic context might have suggested to a person of ordinary skill in the art the specific steps of receiving images of fields from a client via a computer network and returning checked coded information over the network to the client, as recited in claim 1.

The Examiner went on to state that Jansen discloses receiving payment for a service based upon a price per unit of service. In response to the previous Official Action, Applicant pointed out that Jansen charges for service using a conventional model of price per unit time, rather than charging for processing fields containing information on the basis of a price per field, as required by claim 1. In the Examiner’s Response to Arguments in the present Official Action, the Examiner asserted that “the applicant acknowledges” that Jansen “teaches changing [*sic*] based upon a price per unit of service.” This assertion is simply not true, as Applicant acknowledged only that the Examiner had made the statement in question.

Even if it were conceded, however, that charging a price per unit of service was known generally in the art, the Examiner has still failed to show that the specific unit of service – processed fields - recited in claim 1 was taught or suggested by the prior art. The only rationale given by the Examiner for deriving this teaching from Jansen is that “A field is a well known unit.” Although fields may be well-known elements in a form document, this fact does not prove or even suggest that charging for processing based on a price per field processed was known prior to filing of the present patent application. Jansen is directed to vending public multimedia services, not processing of form documents, and so could not possibly have suggested using the number of fields processed as a basis for payment. The Examiner himself acknowledged that Lorie does not disclose “receiving payment for a service based upon a price per unit of service.” Hence, the only teaching of record that might point in the direction of charging for processing based on a price per field processed is impermissible hindsight from the present patent application.

Thus, to summarize, the references cited by the Examiner fail to teach or suggest not just one, but several distinguishing elements of claim 1. The Examiner has fallen far short of the

requirement stated in MPEP 2143.03 that “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”

Therefore, Applicant respectfully reiterates that claim 1 is patentable over the cited art, as are dependent claims 5-11. Apparatus and software claims 19, 23-29, 35 and 36 are also believed to be patentable for the reasons explained above.

Claims 4 and 22 were rejected under 35 U.S.C. 103(a) over Lorie in view of Jansen and further in view of Bruce et al. (U.S. Patent 6,741,724). As in the response to the previous Official Action, Applicant respectfully traverses this rejection on the basis of both the patentability of amended claims 1 and 19 and the disqualification of Bruce as prior art against the present patent application, as explained below.

Claims 12-16, 18, 30-34 and 37 were rejected under 35 U.S.C. 103(a) over Lorie in view of Bruce, while claim 17 was rejected over Lorie in view of Bruce and further in view of Jansen. Applicant respectfully traverses this rejection, on the basis of the Declaration under 37 CFR 1.131 submitted in response to the previous Official Action. This Declaration showed that the invention recited in independent claims 12, 30 and 37 was conceived prior to the filing date of Bruce (March 24, 2000), and that Applicant diligently pursued the constructive reduction to practice of the present invention from March 24, 2000, up to the filing date of the present patent application.

In the present Official Action, the Examiner held that the Declaration was ineffective in overcoming Bruce, because it failed to prove either conception or diligence in reduction to practice. Applicant respectfully submits that the Examiner has misinterpreted both the content of the Declaration and the requirements of 37 CFR 1.131. Given a proper interpretation, as explained below, Applicant’s Declaration clearly disqualifies Bruce as prior art.

On the subject of conception, the Examiner maintained that “not all the limitations of the claims [presumably the limitations of claim 12] are disclosed in Appendix A,” which contains an IBM Disclosure written by Applicant prior to March 24, 2000. Specifically, the Examiner appears to take the position that because the Disclosure does not provide literal support for all the words used in the claim, it does not prove conception of the claimed invention. There is no requirement in the Rules or in MPEP, however, for the sort of literal support the Examiner is seeking. On the contrary, MPEP 715.07(I) makes clear that such literal support is not required:

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety... An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The Examiner took two specific points to be absent from the disclosure: “domains” and “information filled into the field on a form by a plurality of users in communication with the client.” Regarding “domains,” Applicant’s Declaration pointed out two exemplary domains that were mentioned in the disclosure: medical practice offices and insurance. The term “domain” is used in this identical sense in the present patent application, for example: “This domain might be the population of practicing physicians in the United States...” (page 11, lines 12-14). This claim element, in other words, is literally supported by the Declaration itself and is substantively supported in the Disclosure.

Regarding “information filled into the field,” the Examiner maintained that “the disclosure fails to mention information filled into the field on a form by a plurality of users in communication with the client,” but rather stated only that a directory service provider provides filled-in forms to a software integrator. It is clear in the Declaration that the software integrator (“SI”) is identified with the “client” recited in the claim. The Examiner appears to be arguing that since the Disclosure does not explicitly state that the forms in question are filled in by users in communication with the software integrator, a person of ordinary skill in the art would not have understood this limitation. Does the Examiner believe that the software integrator was expected to fill in the form data itself, rather than getting filled-in forms from users? In this regard, MPEP 715.02 states that:

Even if applicant’s 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art...

Considering “all of the evidence presented in its entirety” in the context of “forms processing” (the subject of the Disclosure), there is no question that a person of ordinary skill in this

art, upon reading Applicant's Disclosure, would have understood that the forms in question are filled in by users.

Furthermore, MPEP 715.02(I) goes on to state that:

Where a claim has been rejected under 35 U.S.C. 103 based on Reference A in view of Reference B... the applicant can rely on the teachings of Reference B to show that the difference between what is shown in his or her 37 CFR 1.131... declaration and the claimed invention would have been obvious to one of ordinary skill in the art prior to the date of Reference A.

In the present case, the Examiner has asserted that Lorie ("Reference B") teaches "receiving... information that is filled into the field on the forms by a plurality of users in communication with the client," citing col. 1, lines 16-30, and col. 8, lines 50-67. Thus, even if it were conceded that this element of claim 12 would not have been understood inherently in the context of Applicant's Disclosure, Lorie could, according to the Examiner's own reasoning, be taken to show that this missing element would have been obvious prior to the filing date of Bruce ("Reference A").

Thus, Applicant's Declaration and associated evidence prove that the invention recited in claim 12 was conceived prior to March 24, 2000.

With regard to diligence in reduction to practice, the Examiner maintained that the "evidence submitted is insufficient to establish diligence..." There is no requirement in 37 CFR 1.131 or in MPEP, however, that Applicant submit documentary evidence of diligence. On the contrary, MPEP 715.07(III) points out:

Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).

Applicant's Declaration, as cited by the Examiner in the present Official Action, recited specific facts and dates. No further evidence is required. Therefore, the Examiner had no basis for rejecting Applicant's declaration on the grounds of failing to show "facts establishing diligence."

To summarize, Applicant respectfully submits that the Declaration and supporting evidence submitted in response to the previous Official Action in this case are sufficient to prove conception

of the invention recited in claim 12 prior to March 24, 2000, and diligence in constructive reduction to practice between that date and the filing date of the present patent application. Therefore, Bruce may not be considered prior art against the present patent application, and the rejection of claims 12-18, 30-34 and 37 should be withdrawn.

Applicant believes the remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these remarks, Applicant respectfully submits that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: April 24, 2006

Respectfully submitted,

By 
S. Peter Ludwig

Registration No.: 25,351
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant



Application No. (if known): 09/616,977

Attorney Docket No.: 06727/000H417-US0

Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. **EV762808304US** in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on April 24, 2006
Date

Signature

Nancy Joyce Simmons

Typed or printed name of person signing Certificate

Registration Number, if applicable

212-527-7700
Telephone Number

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Amendment After Final Action Under 37 C.F.R. 1.116 (7 pages)
Amendment Transmittal (1 page)
Return Receipt Postcard